

REMARKS

Following examination, this Application was allowed on August 11, 2000, and the issue fee was timely paid on August 29, 2000.

As requested in the February 10, 2004 Official Action, Applicant supplies the information that was requested. No statutory event capable of defeating patentability has occurred. The issuance of another Notice of Allowance is urged to be in order.

It respectfully is pointed out that the request for information under 37 C.F.R. § 1.105 with respect to the public use and availability of the 'Meinusian' plant outside of the United States bears no relationship to the statutory bases for the denial of patent protection pursuant to Title 35 of the United States Code, and accordingly is not justified under the language of C.F.R. § 1.105 since such information is not "reasonably necessary to properly examine or treat the matter." Also, any publications by Applicant that occurred less than one year prior to the January 28, 1999 filing date of the present Application are not relevant under any circumstances.

Additionally, this request with respect to availability of the plant outside the United States constitutes an unannounced substantive departure from prior practices of the United States Patent and Trademark Office as they have existed for over seventy years that if maintained could substantially limit patent rights and thereby have a substantial adverse impact upon the entire plant industry. Public use and availability of an invention outside the United States is not statutory prior art. Applicant is entitled to continue to rely upon the long-standing practice of the United States Patent and Trademark Office. Accordingly, the recent action by personnel of the United States Patent and Trademark Office is urged to be inappropriate and should be discontinued without delay.

Nevertheless, in a sincere effort to expedite prosecution Applicant provides on information and belief information that was requested to the extent available. It respectfully is submitted that this information when properly evaluated in accordance with the statutory parameters of 35 U.S.C. § 102 presents no statutory impediment to patentability.

- (1) Plants of the 'Meinusian' variety entered the United States on July 21, 1992 and were placed in quarantine in the absence of the release of the variety to the public in the United States. They subsequently were evaluated under the growing conditions of the United States in the absence of release to the public in the United States.
- (2) Plant Breeders Rights Application No. 97/0101 directed to the 'Meinusian' variety was filed in the European Community on January 27, 1997 as indicated in the Declaration filed with the present Plant Patent Application. Reference to this filing in the European Community as well as the proposed varietal denomination appeared in Official Gazette of the Community Plant Variety Office No. 2/1997 dated April 15, 1997. Attached as Exhibit A are copies of the Cover Page and Pages 24, 30, 34 and 41 from this source.
- (3) Plants of the 'Meinusian' variety are identified in the Autumn-Winter 1996 Catalog of Meilland Richardier that was made available to others in France. Attached as Exhibit B is a copy of the Cover Page and Page 19.

(4) Plants of the 'Meinusian' variety were first made available to the public in the United States during December 1999 when they appeared in a catalog of the United States and after the January 28, 1999 filing date in the United States.

(5) Plants of the 'Meinusian' variety were made available to the public in France on May 20, 1996. The public use and availability of a claimed invention in a foreign country more than one year before the filing of a Patent Application in the United States is not prior art and cannot be considered to be an impediment to United States Patent protection under the express language of 35 U.S.C. § 102. See, *Gandy et al. v. Main Belting Co. et al.*, 143 U.S. 587, 12 S.Ct. 598 (1892), and *Allied Colloids Inc. v. American Cyanamid*, 64 F.3d 1570 (Fed. Cir. 1995). Also, the availability of a plant variety in a foreign country has never been considered to be an impediment to variety protection under the Plant Patent Act (i.e., 35 U.S.C. §§ 161 to 165) during the first 70+ years since its enactment in 1930.

One cannot reproduce the 'Meinusian' variety in view of anything that was published more than one year prior to the January 28, 1999 effective filing date of the present Application.

The *In re LeGrice* decision of the Court of Customs and Patent Appeals dated May 4, 1962 and reported at 133 USPQ 365 is controlling authority for Examiners of the U.S. Patent and Trademark Office and must be followed during the examination when a comparable factual situation is presented as in the present application. It was there held that in order to be a statutory bar, a printed publication with respect to

a new plant variety that is sought to be patented under 35 U.S.C. §§ 161 to 165 must be adequate in its teachings to enable the reader in combination with his or her own scientific knowledge of the particular art to be in possession of the plant when taking into consideration the existing "store of knowledge in fields of plant heredity and plant eugenics which one skilled in the art will be presumed to possess." The two rose varieties under discussion in the *LeGrice* case were available to the public outside the United States well more than one year before the filing dates of the Plant Patent Applications that matured into United States Plant Patent Nos. 2,209 and 2,210. This is confirmed at Page 2 of the February 12, 1960 *LeGrice* Board of Appeals Decision where it stated:

The publications indicate that the particular plants were on sale, and presumably also in public use, more than one year prior to the respective filing date of the applications since appellant is indicated as "raiser and distributor." However this question is not in issue since the public use or sale must be in the United States in order to bar a patent and these events, as far as anything suggested by the record is concerned, took place in England. (underlining added)

Such availability of plant material of the claimed varieties abroad was not relevant to the examination in view of the express language utilized by Congress in 35 U.S.C. § 102. Public use and availability of the subject matter of a Patent Application in a foreign country more than one year before the filing date is not an impediment to United States Patent protection. See, the *Gandy et al. v. Main Belting Co., et al.*, Supreme Court decision cited earlier. The Judges at the Court of Customs and Patent Appeals reasonably can be concluded to have considered the underlying facts and the February 12, 1960 decision of the Board of Appeals in detail. It would be grossly improper for the Examiner to overlook the above quotation and to attempt to distinguish the *LeGrice* decision. Had the availability of plants of

the subject *LeGrice* varieties outside the United States been considered to be relevant in its evaluation, it would have been further addressed in the written decision. Such issue had been resolved by the United States Supreme Court many years earlier and was not open for discussion. This *In re LeGrice* decision that was written by the respected patent jurist, Arthur M. Smith, clarified the law with respect to when a printed publication can serve as a statutory bar to plant variety protection and properly has been consistently applied and followed by Examiners of traditional Plant Patents pursuant to 35 U.S.C. §§ 161 to 165 for several decades following its issuance.

The subsequent decision of the Board of Patent Appeals and Interferences in *Ex parte Thomson*, 24 USPQ 2d 1618 (1992) involving a utility Patent Application was not followed by Examiners of the U.S. Patent and Trademark Office for many years for good reason. It should be recognized to constitute an ill-conceived action by the Patent Office administrative tribunal that is unsound from both technical and legal standpoints. It has never been the law with respect to non-plant inventions when similar enablement issues with respect to a publication arise. 35 U.S.C. § 102 was misapplied in *Thomson*. There is no reason for the law in this area to be different when applied to a plant invention. Further the fact situation in the *Thomson* case cannot reasonably be distinguished from that of the controlling Court authority with respect to traditional Plant Patents - *In re Le Grice*. In both instances, there was public use and availability of plant material outside the United States more than one year before the United States filing dates. Also, the cavalier "someday is here" reasoning expressed in the *Thomson* decision should be recognized to be scientifically inaccurate. From a scientific standpoint there is today no way that even

the most skilled plant scientist could reproduce the claimed 'Meinusian' variety from a reading of anything that was published with respect to this variety more than one year prior to the January 28, 1999 effective filing date of the present Plant Patent Application. The mere possibility for one to seek a plant in a foreign country and to bring such plant to the United States has never been an impediment to variety protection in the United States in the absence of a showing that the variety was on sale or in public use in the United States more than one year before the United States filing date. No statutory anticipation has been or is capable of being established with respect to the 'Meinusian' variety.

The Examiner has cited no authority for the assertion that the availability of an invention outside the United States combined with a non-enabling publication has ever been used to create a statutory bar other than the *Ex parte Thomson* decision. As specified at 35 U.S.C. § 161, Plant Patents and Patents for other inventions should be subject to the same statutory provisions "except as otherwise provided." Title 35 provides no exception capable of supporting a different rule for Plant Patents. Accordingly, a rejection under 35 U.S.C. § 102(b) would not withstand an accurate application of the statute as enacted by Congress.

The issuance of another formal Notice of Allowance is urged to be in order and respectfully is requested. Basic fairness to Applicant requires this outcome. If there is any remaining point that requires clarification prior to the allowance of the Application, the Examiner is urged to telephone the undersigned attorney so that the matter can be discussed and resolved at a personal interview.

Respectfully submitted,

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